

**PATENT APPLICATION**

**RESPONSE UNDER 37 CFR §1.116  
EXPEDITED PROCEDURE  
TECHNOLOGY CENTER ART UNIT 1651**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kazuichi ISAKA et al.

Group Art Unit: 1651

Application No.: 10/050,797

Examiner: D. NAFF

Filed: January 18, 2002

Docket No.: 111697

For: METHOD OF REMOVING EXOGENOUS ENDOCRINE-DISRUPTING CHEMICAL  
IN WATER

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the April 18, 2006 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 9, 11, 15, 19 and 25 are pending in this application.

The courtesies extended to Applicant's representative by Examiner Naff at the interview held May 24, 2006, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

**I. Rejection Under 35 U.S.C. §103(a)**

Claims 9, 11, 15, 19 and 25 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable of U.S. Patent No. 6,576,451 ("Sumino") in view of U.S. Patent No. 3,860,490 ("Guttag"). This rejection is respectfully traversed.

As previously explained, the presently claimed subject matter and Sumino were made by or on behalf of parties to a joint research agreement, and the claimed invention was made as a result of activities undertaken under the joint research agreement. Thus, Sumino is not available as a prior art reference under 35 U.S.C. §103(a). The Patent Office has acknowledged this assertion but has alleged that additional evidence is necessary under 35 U.S.C. §103(c). Specifically, the Patent Office requested a statement in the form of a declaration containing evidence of the agreement and date of the agreement, and evidence that the agreement resulted in the claimed invention.

Applicants submit that this additional evidence is not necessary. As explained during the May 24, 2006 interview, the current rules do not require (1) a Declaration, (2) the requested evidence of the agreement, or (3) the date of agreement, as required by the Patent Office in the April 18, 2006 Office Action.

As discussed at length during the May 24, 2006 interview, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if (A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made, (B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and (C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement. See 35 U.S.C. §103(c)(2).

To overcome a rejection under 35 U.S.C. §103(a) via reliance on §103(c)(2), the applicant need only (1) amend the specification to list the parties to the joint research agreement and (2) provide a statement to the effect that the prior art and the claimed invention were made by or on the behalf of parties to a joint research agreement, that was in effect on or before the date the claimed invention was made, and that the claimed invention

was made as a result of activities undertaken within the scope of the joint research agreement. See 37 CFR §1.104(c)(4)(iii).

As requested by Examiner Naff during the May 24, 2006 interview, attached for the Patent Office's convenience is a copy of the the Federal Register, Vol. 70, No. 177, pp. 54259-67 (September 14, 2005), setting forth the final rule changes related to joint research agreements. Applicants have marked the relevant portion of the Federal Register for the Patent Office's convenience. These final rules confirm that the above two requirements are the only requirements that must be satisfied in order for an applicant to take advantage of the safe harbor provisions of 35 U.S.C. §103(c)(2)

As indicted in the Statement Regarding Joint Research Agreement attached to the Amendment filed July 29, 2005, the claimed invention and Sumino were made by or on behalf of parties to a joint research agreement that was in effect on or before the date of the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. Furthermore, the specification was amended in the Amendment filed July 29, 2005, to disclose the names of the parties to the joint research agreement.

Applicants thus submit that all of the requirements necessary to overcome a rejection under 35 U.S.C. §103(a) via reliance on §103(c)(2) have been met. As a result, Sumino may not be relied upon in a §103(a) rejection.

For the foregoing reasons, Applicants submit that Sumino is not a proper prior art reference. Guttag alone does not teach or suggest all of the features recited in claims 9, 11, 15, 19 and 25. Reconsideration and withdrawal of the rejection are thus respectfully requested.

**II. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 9, 11, 15, 19 and 25 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

*Leana Levin*

James A. Oliff  
Registration No. 27,075

Leana Levin  
Registration No. 51,939

JAO:LL/hs

Attachment:

Federal Register, Vol. 70, No. 177, pp. 54259-67 (September 14, 2005)

Date: June 16, 2006

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
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On May 22, 2003, the United Nations Security Council adopted Resolution 1483, which substantially lifted the multilateral economic sanctions with respect to Iraq. On July 29, 2004, the President issued Executive Order 13350 terminating the national emergency declared in Executive Order 12722 and revoking Executive Orders 12722 and 12724 and all other Executive orders based on that national emergency. Notwithstanding the termination of the national emergency, this new Executive order, pursuant to the President's authority under section 207 of IEEPA (50 U.S.C. 1706), continues prohibitions with regard to transactions involving any property blocked pursuant to Executive Order 12722 or Executive Order 12724 that remains blocked as of July 30, 2004. Moreover, the new Executive order indicates that the termination "shall not affect any action taken or proceeding pending but not finally concluded" as of July 30, 2004, any action or proceeding based on any act committed prior to such date, or "any rights or duties that had matured or penalties that were incurred" prior to that date.

Because property blocked as of the termination of sanctions against Iraq remains blocked pursuant to Executive Order 13350, any Iraqi debt blocked pursuant to those sanctions has remained blocked. Because of the lifting of multilateral and U.S. sanctions against Iraq, including the resolution of issues relating to Iraqi debt, the Office of Foreign Assets Control is today issuing a new general license unblocking debt in which the Government of Iraq has an interest, subject to certain conditions.

First, notwithstanding the new general license, transactions that remained prohibited by paragraphs (b)(3) and (b)(5) of 31 CFR 575.533 continue to remain prohibited. Second, the general license does not authorize the purchase, exchange or settlement of debt in which the Government of Iraq has an interest utilizing funds or other property that is blocked pursuant to this part.

#### Procedural Matters

Because the Iraqi Sanctions Regulations involve a foreign affairs function of the United States, the provisions in the Administrative Procedure Act (5 U.S.C. 553) requiring notice and public procedure and a delayed effective date are inapplicable. Because no notice of proposed rulemaking is required, the provisions of the Regulatory Flexibility Act (5 U.S.C. Chapter 6) do not apply.

#### Electronic and Facsimile Availability

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#### Paperwork Reduction Act

The collections of information related to these regulations can be found in 31 CFR part 501. Pursuant to the Paperwork Reduction Act of 1995 (44 U.S.C. 3507) those collections of information have been previously approved by the Office of Management and Budget under control number 1505-0164.

#### List of Subjects in 31 CFR Part 575

Administrative practice and procedure, Banks, banking, Blocking of assets, Foreign trade, Iraq, Penalties, Sanctions.

■ For the reasons set forth in the preamble, 31 CFR chapter V is amended as follows:

#### PART 575—IRAQI SANCTIONS REGULATIONS

■ 1. The authority citation for part 575 continues to read as follows:

Authority: 3 U.S.C. 301; 18 U.S.C. 2332d; 22 U.S.C. 287c; Pub. L. 101-410, 104 Stat. 890 (28 U.S.C. 2461 note); 31 U.S.C. 321(b); 50 U.S.C. 1601-1651, 1701-1706; Pub. L. 101-513, 104 Stat. 2047-2055 (50 U.S.C. 1701 note); E.O. 12722, 55 FR 31803, 3 CFR 1990 Comp., p. 294; E.O. 12724, 55 FR 33089, 3 CFR, 1990 Comp., p. 297; E.O. 12817, 57 FR 48433, 3 CFR, 1992 Comp., p. 317; E.O. 13350, 69 FR 46055, July 29, 2004.

#### Subpart E—Licenses, Authorizations, and Statements of Licensing Policy

■ 2. A new section 575.535 is added to read as follows:

##### § 575.535 Iraqi Debt Unblocked.

(a) Except as provided in paragraph (b) of this section, all transactions

otherwise prohibited by this part that involve debts in which the Government of Iraq has an interest are authorized.

(b) For purposes of this part:

(1) This section does not authorize transactions that remain prohibited under the terms of paragraphs (b)(3) and (b)(5) of § 575.533 of this part.

(2) This section does not authorize the purchase, exchange or settlement of debt in which the Government of Iraq has an interest utilizing funds or other property that is blocked pursuant to this part.

Dated: September 6, 2005.

Robert W. Werner,  
Director, Office of Foreign Assets Control.

Stuart A. Levey,  
Under Secretary of the Treasury, Office of  
Terrorism and Financial Intelligence,  
Department of the Treasury.

[FR Doc. 05-18245 Filed 9-9-05; 12:57 pm]

BILLING CODE 4810-25-1

#### DEPARTMENT OF COMMERCE

#### Patent and Trademark Office

#### 37 CFR Parts 1 and 3

[Docket No.: 2004-P-034]

RIN 0651-AB76

#### Changes To Implement the Cooperative Research and Technology Enhancement Act of 2004

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

**SUMMARY:** The Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act) amends the patent laws to provide that subject matter developed by another person shall be treated as owned by the same person or subject to an obligation of assignment to the same person for purposes of determining obviousness if three conditions are met: The claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made; the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement. The United States Patent and Trademark Office (Office) is revising the rules of practice in patent cases to implement the CREATE Act.

**DATES:** Effective Date: September 14, 2005.

**Applicability Date:** The changes in this final rule apply to any patent granted on or after December 10, 2004.

**FOR FURTHER INFORMATION CONTACT:** Robert A. Clarke, or Jeanne M. Clark, Senior Legal Advisors, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (571) 272-7704, by mail addressed to: Box Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or by facsimile to (571) 273-7735, marked to the attention of Robert A. Clarke.

**SUPPLEMENTARY INFORMATION:** The CREATE Act amends 35 U.S.C. 103(c) to provide that subject matter developed by another person shall be treated as owned by the same person or subject to an obligation of assignment to the same person for purposes of determining obviousness if three conditions are met: (1) The claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made; (2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement. See Pub. L. 108-453, 118 Stat. 3596 (2004). Section 2 of the CREATE Act specifically amended 35 U.S.C. 103(c) to provide that:

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if—

(A) The claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) The claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

Section 3 of the CREATE Act provides that its amendments shall apply to any patent (including any reissue patent) granted on or after December 10, 2004. The CREATE Act provides that its amendments shall not affect any final decision of a court or the Office rendered before December 10, 2004, and shall not affect the right of any party in any action pending before the Office or a court on December 10, 2004, to have that party’s rights determined on the basis of the provisions of title 35, United States Code, in effect on December 9, 2004. Since the CREATE Act also includes the amendment to 35 U.S.C. 103(c) made by § 4807 of the American Inventors Protection Act of 1999 (see Pub. L. 106-113, 113 Stat. 1501, 1501A-591 (1999)), the change of “subsection (f) or (g)” to “one or more of subsections (e), (f), or (g)” in 35 U.S.C. 103(c) is now also applicable to applications filed prior to November 29, 1999, which were pending on December 10, 2004.

35 U.S.C. 103(c) as amended by the CREATE Act continues to apply only to subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f) or (g), and which is being relied upon in a rejection under 35 U.S.C. 103. If the rejection is anticipation under 35 U.S.C. 102(e), (f), or (g), 35 U.S.C. 103(c) cannot be relied upon to disqualify the subject matter in order to overcome the anticipation rejection.

Because the CREATE Act applies only to patents granted on or after December 10, 2004, the recapture doctrine may prevent the presentation of claims in reissue applications that had been amended or cancelled (e.g., to avoid a rejection under 35 U.S.C. 103(a) based upon subject matter that may now be disqualified under the CREATE Act) during the prosecution of the application which resulted in the patent for which reissue is sought. See H.R. Rep. No. 108-425, at 6-7 (2003).

The Office published an interim rule to revise the rules of practice in title 37 of the Code of Federal Regulations (CFR) to implement the CREATE Act. See *Changes to Implement the Cooperative Research and Technology Enhancement Act of 2004*, 70 FR 1818 (Jan. 11, 2005), 1291 Off. Gaz. Pat. Office 58 (Feb. 8, 2005) (interim rule). This final rule further revises the rules of practice in title 37, CFR, to implement the CREATE Act.

## Discussion of Specific Rules

**Section 1.17:** Section 1.17(i) is amended in this final rule to add the processing fee required by § 1.71(g)(2) (see the discussion regarding § 1.71(g)(2)).

**Section 1.52:** Section 1.52(e)(5) is amended in this final rule to change “§ 1.77(b)(4)” to “§ 1.77(b)(5)” for consistency with the change to § 1.77(b).

**Section 1.71:** Section 1.71 was amended in the interim rule to add new § 1.71(g). An application must disclose or be amended to disclose the names of the parties to a joint research agreement to invoke the “safe harbor” provision of 35 U.S.C. 103(c) as amended by the CREATE Act. See 35 U.S.C. 103(c)(2)(C). Section 1.71(g) provides for the situation in which an application discloses or is amended to disclose the names of the parties to a joint research agreement to invoke the “safe harbor” provision of 35 U.S.C. 103(c) as amended by the CREATE Act. Section 1.71(g)(1) specifically provides that the specification may disclose or be amended to disclose the name of each party to the joint research agreement because this information is required by 35 U.S.C. 103(c)(2)(C). This final rule eliminates the requirements for: (1) The date the joint research agreement was executed; and (2) a concise statement of the field of the claimed invention.

Section 1.71(g)(2) provides that an amendment under § 1.71(g)(1) must be accompanied by the processing fee set forth in § 1.17(i) if it is not filed within one of the following time periods: (1) Within three months of the filing date of a national application; (2) within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; (3) before the mailing of a first Office action on the merits; or (4) before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

Section 1.71(g)(3) provides that if an amendment under § 1.71(g)(1) is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. Section 1.71(g)(3) also provides that if the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 for the amendment to be effective. The requirements of § 1.71(g)(3) (correction of the patent by a certificate of correction under 35 U.S.C. 255 and 37

CFR 1.323) also apply in the situation in which such an amendment is not filed until after the date the patent was granted (in a patent granted on or after December 10, 2004). It is unnecessary to file a reissue application or request for reexamination of the patent to submit the amendment and other information necessary to take advantage of 35 U.S.C. 103(c) as amended by the CREATE Act. See H.R. Rep. No. 108-425, at 9 ("[t]he omission of the names of parties to the agreement is not an error that would justify commencement of a reissue or reexamination proceeding").

Section 1.71(g)(3) is amended in this final rule to eliminate the provision that the processing fee under § 1.17(i) is required if an amendment under § 1.71(g)(1) is submitted after payment of the issue fee. The processing fee under § 1.17(i) is required for an amendment under § 1.71(g)(1) submitted after the time periods set forth in § 1.71(g)(2), even if the amendment under § 1.71(g)(1) is also submitted after payment of the issue fee or after a patent is granted.

The submission of such an amendment remains subject to the rules of practice: e.g., §§ 1.116, 1.121, and 1.312. For example, if an amendment under § 1.71(g) is submitted in an application under final rejection to overcome a rejection under 35 U.S.C. 103(a) based upon a U.S. patent which qualifies as prior art only under 35 U.S.C. 102(e), the examiner may refuse to enter the amendment under § 1.71(g) if it is not accompanied by an appropriate terminal disclaimer (§ 1.321(d)). This is because such an amendment may necessitate the reopening of prosecution (e.g., for entry of a double patenting rejection).

If an amendment under § 1.71(g) is submitted to overcome a rejection under 35 U.S.C. 103(a) based upon a U.S. patent or U.S. patent application publication which qualifies as prior art only under 35 U.S.C. 102(e), and the examiner withdraws the rejection under 35 U.S.C. 103(a), the examiner may need to issue an Office action containing a new double patenting rejection based upon the disqualified patent or patent application publication. In these situations, such Office action can be made final, provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in § 1.97(c) with the fee set forth in § 1.17(p). The Office action is properly made final because the new double patenting rejection was necessitated by amendment of the application by applicant. This is the

case regardless of whether the claims themselves have been amended.

Section 1.76: Section 1.76(b)(5) is amended in this final rule to change "§ 1.78(a)(4)" to "§ 1.78(a)(5)" to correct a typographic error.

Section 1.77: Section 1.77 was amended in the interim rule to provide for the names of the parties to a joint research agreement in the preferred arrangement of the specification. No further amendment to § 1.77 is made in this final rule.

Section 1.96: Section 1.96(c) is amended in this final rule to change "§ 1.77(b)(4)" to "§ 1.77(b)(5)" for consistency with the change to § 1.77(b).

Section 1.104: Section 1.104(c)(4) is amended for consistency with the amendment to 35 U.S.C. 103(c) and to include the requirements for the statement to invoke the prior art disqualification under the CREATE Act. Section 1.104 is also amended to change "same person or organization" to "same person" for consistency with 35 U.S.C. 103(c) (no change in substance).

Once an examiner has established a *prima facie* case of obviousness under 35 U.S.C. 103(a), the burden is on the applicant to overcome the rejection by invoking 35 U.S.C. 103(c) as amended by the CREATE Act. Such a rejection under 35 U.S.C. 103(a) may be based upon subject matter (whether a patent document, publication, or other evidence) which qualifies as prior art under only one or more of 35 U.S.C. 102(e), (f), or (g). To overcome such a rejection via the CREATE Act, the applicant must provide a statement in compliance with § 1.104(c)(4) to the effect that the prior art and the claimed invention were made by or on the behalf of parties to a joint research agreement, within the meaning of 35 U.S.C. 103(c)(3), which was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. 35 U.S.C. 103(c)(3) defines a "joint research agreement" as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention, that was in effect on or before the date the claimed invention (under examination or reexamination) was made. The statement should either be on or begin on a separate sheet and must not be directed to other matters (§ 1.4(c)). The statement must be signed in accordance with § 1.33(b).

In addition to providing a statement, the applicant must also amend the

specification to disclose the names of the parties to the joint research agreement in compliance with § 1.71(g)(1). If the applicant disqualifies the subject matter relied upon by the examiner in accordance with the CREATE Act and the procedures set forth in this final rule, the examiner will treat the application under examination and the 35 U.S.C. 102(e), (f), or (g) prior art as if they are commonly owned for purposes of 35 U.S.C. 103.

Section 1.109: Section 1.109 was added in the interim rule, but is removed and reserved in this final rule. This final rule sets forth guidelines for double patenting rejections based upon a patent or application that is not commonly owned but was disqualified under 35 U.S.C. 103(c) as resulting from activities undertaken within the scope of a joint research agreement and other double patenting rejections in the Manual of Patent Examining Procedure (MPEP) rather than in the rules of practice. MPEP 804 sets forth the Office's guidelines for double patenting rejections.

Congress recognized that this amendment to 35 U.S.C. 103(c) would result in situations in which there would be double patenting between applications not owned by the same party. See H.R. Rep. No. 108-425, at 5-6 (2003). Therefore, the Office is providing the following guidelines for double patenting rejections based upon a patent or application that is not commonly owned but was disqualified under 35 U.S.C. 103(c) as resulting from activities undertaken within the scope of a joint research agreement, which will be incorporated into the next revision of the MPEP. A double patenting rejection will be made in an application or patent under reexamination (assuming that the applicant or patentee has not already filed the appropriate terminal disclaimer) if: (1) The application or patent under reexamination claims an invention that is not patentably distinct from an invention claimed in a non-commonly owned application or patent; (2) the application or patent and the non-commonly owned application or patent are by or on behalf of parties to a joint research agreement; and (3) a statement has been filed under § 1.104(c)(4)(iii) to disqualify the non-commonly owned application or patent under 35 U.S.C. 103(c)(2). Thus, the application or patent and the subject matter disqualified under 35 U.S.C. 103(c), as amended by the CREATE Act, will be treated as commonly owned for purposes of double patenting analysis. Such a double patenting rejection will be made regardless of whether the

application or patent and the non-commonly owned patent or application have the same or a different inventive entity. This double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(d).

**Section 1.130:** Section 1.130 was amended in the interim rule to remove and reserve § 1.130(b). No further amendment to § 1.130 is made in this final rule.

**Section 1.321:** Section 1.321(c) is amended to change "judicially created double patenting rejection" to "judicially created double patenting" because double patenting may exist regardless of whether a double patenting rejection has been made.

Section 1.321(d) is added to provide the terminal disclaimer requirements for the double patenting situations which arise as a result of the CREATE Act. See H.R. Rep. No. 108-425, at 6 (the Office may require a terminal disclaimer when double patenting is determined to exist for two or more claimed inventions for any application for which the applicant takes advantage of the "safe harbor" provision in 35 U.S.C. 103(c) as amended by the CREATE Act). The legislative history of the CREATE Act specifically states that:

Congress intends that parties who seek to benefit from this Act to waive the right to enforce any patent separately from any earlier patent that would otherwise have formed the basis for an obviousness-type double patenting rejection. Further, Congress intends that parties with an interest in a patent that is granted solely on the basis of the amendments made pursuant to this Act to waive requirements for multiple licenses. In other words, the requirements under current law for parties to terminally disclaim interests in patents that would otherwise be invalid on "obviousness-type" double patenting grounds are to apply, *mutatis mutandis*, to the patents that may be issued in circumstances made possible by this Act.

See H.R. Rep. No. 108-425, at 6.

Section 1.321(d) specifically sets forth the requirements for a terminal disclaimer that is filed in a patent application or in a reexamination proceeding to obviate a double patenting based upon a U.S. patent or application that is not commonly owned but was disqualified under 35 U.S.C. 103(c). First, the terminal disclaimer must comply with the provisions of §§ 1.321(b)(2) through (b)(4). Second, the terminal disclaimer must be signed by the applicant in accordance with § 1.321(b)(1) if filed in a patent application, or be signed by the patentee in accordance with § 1.321(a)(1) if filed in a reexamination proceeding. Third, the terminal disclaimer must also include a provision that the owner of

the application or patent waives the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the disqualified patent or any patent granted on the disqualified application, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the disqualified patent, or any patent granted on the disqualified application are not separately enforced. Section 1.321(d) does not include a provision that the applicant or patentee agrees that such waiver and agreement shall be binding upon the owner of the rejected application or patent, its successors, or assigns because this is provided for in § 1.321(b).

This final rule eliminates the following requirements: (1) That the owner of the disqualified patent or application must sign the terminal disclaimer; (2) that there be a waiver of the right to separately license the application or patent and the disqualified patent or application; and (3) that the agreement that the application or patent and the disqualified patent or application shall be enforceable only during the period that the patent or application and the disqualified patent or application are not separately licensed.

**Section 3.11:** Section 3.11(c) was added in the interim rule to provide that the Office will record a joint research agreement or an excerpt of a joint research agreement as provided in 37 CFR part 3. Section 3.11(c) as adopted in the interim rule provided that such a joint research agreement, or excerpt of a joint research agreement, must include the name of each party to the joint research agreement, the date the joint research agreement was executed, and a concise statement of the field of invention. This final rule eliminates the requirements that such a joint research agreement, or excerpt of a joint research agreement, include the name of each party to the joint research agreement, the date the joint research agreement was executed, and a concise statement of the field of invention (see discussion of the changes to § 1.71(g) in this final rule). Thus, § 3.11(c) as amended in this final rule simply provides that the Office will record a joint research agreement or an excerpt of a joint research agreement as provided in 37 CFR part 3.

**Section 3.31:** Section 3.31(g) was added in the interim rule to set forth the requirements for the cover sheet required by § 3.28 seeking to record a joint research agreement or an excerpt of

a joint research agreement as provided by § 3.11(c). First, the cover sheet must identify the document as a "joint research agreement" (preferably, by checking the joint research agreement checkbox in box 3 of Office form PTO-1595 (March 2005)). Second, the cover sheet must indicate the name of the owner of the application or patent (preferably, in the space provided for the name and address of the party receiving the interest in box 2 of Office form PTO-1595). Third, the cover sheet must indicate the name of every other party to the joint research agreement (preferably, in the space provided for the name of the party conveying the interest in box 1 of Office form PTO-1595). Additional names may be provided on an attached sheet if necessary. Fourth, the cover sheet must indicate the date the joint research agreement was executed (preferably, in the space provided for the execution date in box 3 of Office form PTO-1595). No further amendment to § 3.31 is made in this final rule.

**Response to comments:** The Office published an interim rule providing changes to the Office's practice for implementing the CREATE Act and requesting public comment on these changes. See *Changes to Implement the Cooperative Research and Technology Enhancement Act of 2004*, 70 FR at 1818, 1291 *Off. Gaz. Pat. Office* at 59. The Office received twenty-four written comments (from intellectual property organizations, patent practitioners, and the general public) in response to this interim rule. The comments and the Office's responses to the comments follow:

**Comment 1:** Several comments suggested that the effective date provisions of the CREATE Act did not alter the effective date of the amendments to 35 U.S.C. 103(c) by the American Inventors Protection Act of 1999 (AIPA) (see Pub. L. 106-113, 113 Stat. 1501, 1501A-591 (1999)). Accordingly, the comments argued that only applications filed on or after November 29, 1999 (the effective date of the AIPA amendments to 35 U.S.C. 103(c)) can disqualify 102(e) prior art used in a rejection under 35 U.S.C. 103(c) based on common ownership.

**Response:** The Office's interpretation is based on the plain language of the Act. Section 3 of the CREATE Act provides that "[t]he amendments made by this Act shall apply to any patent granted on or after the date of enactment of this Act." The CREATE Act rewrote 35 U.S.C. 103(c) in its entirety and included the amendment to 35 U.S.C. 103(c) made by § 4807 of the American Inventors Protection Act of 1999. The



legislative history of the CREATE Act does not elaborate further on this issue. The comments do not provide any authority for any alternative interpretation. Accordingly, the effective date provision of the CREATE Act applies to 35 U.S.C. 103(c) in its entirety.

In addition, the alternative interpretation presented by the comments would lead to an anomalous application of the prior art exclusion under 35 U.S.C. 103(c), in that in applications filed prior to November 29, 1999, but pending on or after December 10, 2004, prior art available under only 35 U.S.C. 102(e) could not be excluded by common owners under 35 U.S.C. 103(c), but could be excluded by parties to a joint research agreement under 35 U.S.C. 103(c)(2).

In any event, applicants currently still have the option of refiling any pending application that was filed before November 29, 1999, to avoid any possible challenge to the application of the AIPA amendments to 35 U.S.C. 103(c) to their application.

**Comment 2:** One comment expressed disagreement with the Office's position that the recapture doctrine may prevent the presentation of claims in reissue applications that had been amended or cancelled (e.g., to avoid a rejection under 35 U.S.C. 103(a) based upon subject matter that may now be disqualified under the CREATE Act) during the prosecution of the application which resulted in the patent being reissued.

**Response:** The statement concerning the recapture doctrine in the interim rule is simply a restatement of what is stated in the legislative history of the CREATE Act concerning the recapture doctrine. See H.R. Rep. No. 108-425, at 6-7 (2003).

**Comment 3:** Several comments suggested that the requirements for the statement to invoke the prior art exclusion under the CREATE Act should be put into a regulation. In addition, the comments objected to the requirement that the applicant or the assignee must sign the statement. Furthermore, the comments expressed concern over filing a statement that might be perceived as making an admission that the disqualified reference is "prior art."

**Response:** The requirements for the statement have been placed into § 1.104(c)(4), and the requirement for signature for the statement is now the same as for any other correspondence as set forth in § 1.33(b). Therefore, a registered practitioner will be allowed to sign the statement in accordance with § 1.33.

With respect to the use of the term "prior art" in the statement, it is noted that 35 U.S.C. 103(c)(1) uses the term "prior art" in its first sentence. Thus, § 1.104(c)(4) uses terminology consistent with 35 U.S.C. 103(c)(1).

**Comment 4:** Several comments questioned whether an interim rule was necessary or justified to implement the CREATE Act. The comments suggested that the statutory language was clear and there was no need to implement regulations.

**Response:** The Office believes that implementing regulations were necessary, for example, to: (1) Advise applicants on how to amend an application to name the parties to a joint research agreement; (2) permit a terminal disclaimer by a party who does not also own the application or patent forming the basis of the double patenting rejection; and (3) provide for the recordation of a joint research agreement in the Office's assignment records.

**Comment 5:** Several comments were critical of the requirements of § 1.71(g)(1) as added in the interim rule. Some comments stated that the requirements are unnecessarily complicated and suggested deleting those not required by statute. Other comments requested clarification of the requirements or suggested alternative requirements.

**Response:** Section 1.71(g)(1) has been amended to require only the names of the parties to the joint research agreement, which is required by 35 U.S.C. 103(c)(2)(C). Comments pertaining to requirements not recited in the statute (e.g., the execution date or the concise statement of the claimed invention) are moot in view of the amendment to § 1.71(g)(1) in this final rule.

**Comment 6:** Several comments requested the definition of terms such as "joint research agreement," "execution date," "invention made," and "not patently distinct."

**Response:** The term "joint research agreement" is defined in 35 U.S.C. 103(c)(3) and is further discussed in the legislative history of the CREATE Act. The term "execution date" is no longer used in § 1.71(g)(1), and therefore, there is no need to define it in the rules of practice. The terms "invention made" and "not patently distinct" are defined by case law. See e.g., *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982) ("invention made"); and *In re Bratt*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991) ("not patently distinct") and *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) (same). Accordingly, there is no need to provide explicit

definitions for these terms in this final rule.

**Comment 7:** One comment requested that the Office impose a requirement that a party invoking the CREATE Act prior art exclusion must notify the other parties to the joint research agreement prior to invoking the prior art exclusion. In addition, the comment also requested a requirement that parties to a joint research agreement be disclosed in the disqualified reference.

**Response:** A requirement that a party invoking the CREATE Act prior art exclusion must notify the other parties to the joint research agreement prior to invoking the prior art exclusion is a requirement that could be a part of the joint research agreement if it is desired by one or more parties to the joint research agreement. This type of requirement is better dealt with during the bargaining stage between the parties to the joint research agreement. In addition, 35 U.S.C. 103(c)(2) does not include such a requirement to invoke the prior art exclusion. Likewise, the requirement that the parties to the joint research agreement be named in the disqualified reference could also be set forth in the joint research agreement if desired. Furthermore, 35 U.S.C. 103(c)(2) does not require that the parties to the joint research agreement be disclosed in the disqualified reference.

**Comment 8:** One comment requested that the Office impose a requirement that the joint research agreement must be disclosed in the specification prior to a patent issuing to invoke the CREATE Act prior art exclusion. The comment stated such a change is necessary to allow a competitor to easily know whether the patentee can disqualify prior art that the competitor may use to support an invalidity defense.

**Response:** This comment goes against the great weight of the comments submitted and is not adopted. In addition, 35 U.S.C. 103(c)(2) does not require entry into the specification prior to a patent issuing in order to invoke the prior art exclusion under the CREATE Act.

**Comment 9:** Several comments suggested that the processing fee required by § 1.71(g)(2) is unnecessary. The comments requested that the fee be eliminated, or alternatively, that the time period for invoking the CREATE Act exclusion without a fee be extended until after the first time a rejection using prior art owned by a party to the joint research agreement is applied.

**Response:** The processing fee required by § 1.71(g)(2) furthers the Office's compact prosecution goals by encouraging applicants to disqualify

prior art under the CREATE Act before examination begins. The processing fee helps recover the cost of any additional work that may be required by applicant's failure to notify the Office of prior art that could have been disqualified before the examination process has begun.

**Comment 10:** Several comments requested that § 1.71(g)(3) be rewritten to be more consistent with the requirements of § 1.71(g)(1).

**Response:** The requirements in § 1.71(g)(3) are consistent with the requirements of § 1.71(g)(1) because of the amendments made to § 1.71(g)(1) in this final rule.

**Comment 11:** Several comments suggested § 1.71(g)(3) should be rewritten to be more clear by stating this rule is "notwithstanding § 1.312" and by stating that a certificate of correction is effective upon submission as opposed to when it is granted.

**Response:** Section 1.71(g)(3) is not in conflict with § 1.312. Section 1.312 does not allow for amendments filed after payment of the issue fee, and § 1.71(g)(3) does not provide that an amendment under § 1.71(g)(1) submitted after payment of the issue fee will be entered. Rather, § 1.71(g)(3) advises applicants that the patent as issued may not necessarily include the names of the parties to the joint research agreement if an amendment under § 1.71(g)(1) is submitted after payment of the issue fee (because the rules of practice do not permit an amendment to an application after payment of the issue fee), and that if the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction under 35 U.S.C. 255 and § 1.323 for the amendment to be effective.

The request to revise the rule to include the statement that the certificate of correction is effective upon submission would not be consistent with the case law concerning certificates of correction. See, e.g., *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 56 USPQ2d 1161 (Fed. Cir. 2000).

**Comment 12:** One comment requested clarification concerning when an examiner can make an obvious double patenting rejection final if there are common inventors or assignees.

**Response:** If an amendment under § 1.71(g) is submitted to overcome a rejection under 35 U.S.C. 103(a) based upon a U.S. patent or U.S. patent application publication which qualifies as prior art only under 35 U.S.C. 102(e), and the examiner withdraws the

rejection under 35 U.S.C. 103(a), but issues an Office action containing a new double patenting rejection based upon the disqualified patent or patent application publication, the Office action can be made final regardless of whether there are common inventors or assignees (provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in § 1.97(c) with the fee set forth in § 1.17(p)).

**Comment 13:** Several comments requested that the processing fee stated in § 1.71(g)(2) be added to § 1.17(i).

**Response:** The processing fee is added to § 1.17(i) in this final rule.

**Comment 14:** One comment objected that § 1.71(g) requires more than the CREATE Act, and argued that the CREATE Act requires only the names of the parties to the joint research agreement who are the owners of an application or patent invoking the CREATE Act and the names of the owners of the disqualified application or patent.

**Response:** This comment goes against the clear statutory requirement that the names of the parties to the joint research agreement must be disclosed in order to invoke the prior art exclusion under the CREATE Act. The statute did not limit the required disclosure to just the owners of the patent rights involved.

**Comment 15:** One comment stated that § 1.104 uses inconsistent terminology.

**Response:** Section 1.104 has been amended to include the requirements for the statement to invoke the CREATE Act prior art exclusion. In addition, § 1.104 has been revised to be consistent with the terminology used in 35 U.S.C. 103(c), which uses both terms "persons" and "parties."

**Comment 16:** Many comments requested clarification of § 1.109, including clarification of when double patenting under § 1.109(b) would apply.

**Response:** Section 1.109 has been removed and this final rule includes guidelines concerning double patenting involving CREATE Act situations. The guidelines provided in this final rule were made after consideration of the comments submitted regarding § 1.109, with many of the comments being adopted. For example, the guidelines clearly set forth that double patenting rejections based on applications or patents to parties of a joint research agreement will only be made after the CREATE Act exclusion has been invoked. In addition, the guidelines do not require that the invention of the disqualified patent be made as a result

of the activities within the scope of the joint research agreement as § 1.109(b) required in the interim rule.

**Comment 17:** Several comments questioned whether the Office has the authority to restrict licensing practice in the provisions of § 1.321(d) introduced in the interim rule. In addition, the comments expressed concern that the provisions of § 1.321(d) went beyond what is required by the CREATE Act and its legislative history.

**Response:** Section 1.321(d) has been amended in this final rule to remove several requirements set forth in the interim rule. First, terminal disclaimers no longer are required to have any restriction on licensing to overcome an obvious double patenting rejection based on prior art of a party to a joint research agreement. Second, the requirement that the owner of the disqualified application or patent sign the terminal disclaimer is removed. Therefore, the removal of these requirements from the provisions of § 1.321(d) has simplified the process of filing the terminal disclaimer while still maintaining the goals of the CREATE Act and its legislative history. Furthermore, the removal of these requirements of § 1.321(d) render moot many of the comments pertaining to this section.

**Comment 18:** Several Comments stated that the assignment rules in § 3.11 and § 3.31 should be more consistent with the requirements of § 1.71(g)(1).

**Response:** These comments are moot in view of the changes to § 1.71(g)(1) in this final rule. Section 1.71(g)(1) no longer requires the execution date and concise statement of the claimed invention and is limited to the statutory requirement of the names of the parties to the joint research agreement.

**Comment 19:** One comment suggested that the Office should consider requiring recordation of a notice that a terminal disclaimer has been filed to overcome a double patenting rejection to assist the public in finding such a terminal disclaimer.

**Response:** There is no need to require a separate recordation of a terminal disclaimer because any patent in which a terminal disclaimer has been filed has such a notation on the front page of the patent. In addition, any terminal disclaimer in the file of an issued patent can be reviewed by viewing the patent image file wrapper via the Patent Application Information Retrieval (PAIR) system.

#### Rule Making Considerations

**Administrative Procedure Act:** The changes in this final rule relate solely to the procedures to be followed in

prosecuting a patent application: *i.e.*, submitting the amendment necessary to invoke the "safe harbor" provision of 35 U.S.C. 103(c) as amended by the CREATE Act, filing of the type of terminal disclaimer necessary to overcome the double patenting rejection that may arise as a result of the CREATE Act, and submitting joint research agreements or excerpts of joint research agreements for recording by the Office. Therefore, these rule changes involve interpretive rules, or rules of agency practice and procedure under 5 U.S.C. 553(b)(A), and prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). See *Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are "rules of agency organization, procedure, or practice" and are exempt from the Administrative Procedure Act's notice and comment requirement); see also *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1549–50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (the rules of practice promulgated under the authority of former 35 U.S.C. 6(a) (now in 35 U.S.C. 2(b)(2)) are not substantive rules (to which the notice and comment requirements of the Administrative Procedure Act apply)), and *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) ("it is extremely doubtful whether any of the rules formulated to govern patent or trade-mark practice are other than 'interpretive rules, general statements of policy, \* \* \* procedure, or practice.'") (quoting C.W. Ooms, *The United States Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 153 (1948)). Accordingly, prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553(b)(A) (or any other law), and thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) (or any other law).

**Regulatory Flexibility Act:** As discussed previously, the changes in this final rule involve rules of agency practice and procedure under 5 U.S.C. 553(b)(A), and prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553(b)(A) (or any other law). As prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553 (or any other law) for the changes in this final rule, a regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required for the changes in this final rule. See 5 U.S.C. 603.

**Executive Order 13132:** This rule making does not contain policies with

federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

**Executive Order 12866:** This rule making has been determined to be significant for purposes of Executive Order 12866 (Sept. 30, 1993).

**Paperwork Reduction Act:** This rule making involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this final rule have been reviewed and previously approved by OMB under the following control numbers: 0651–0027, 0651–0031, 0651–0032, and 0651–0033. The United States Patent and Trademark Office is not resubmitting the information collections listed above to OMB for its review and approval because the changes in this notice do not affect the information collection requirements associated with these information collections.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503. (Attn: PTO Desk Officer).

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### List of Subjects

##### 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

##### 37 CFR Part 3

Administrative practice and procedure, Inventions and patents, Reporting and record keeping requirements.

■ For the reasons set forth in the preamble, the interim rule amending 37 CFR Parts 1 and 3 which was published at 70 FR 1818–1824 on January 11, 2005, is adopted as final with the following changes:

#### PART 1—RULES OF PRACTICE IN PATENT CASES

■ 1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

■ 2. Section 1.17 is amended by revising paragraph (i) to read as follows:

##### § 1.17 Patent application and reexamination processing fees.

\* \* \* \* \*

(i) Processing fee for taking action under one of the following sections which refers to this paragraph.....\$130.00.

§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.

§ 1.41—for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by § 1.63, except in provisional applications.

§ 1.48—for correcting inventorship, except in provisional applications.

§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.

§ 1.53(b)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§ 1.55—for entry of late priority papers.

§ 1.71(g)(2)—for processing a belated amendment under § 1.71(g).

§ 1.99(e)—for processing a belated submission under § 1.99.

§ 1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§ 1.53(d)).

§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d)—for requesting deferred examination of an application.

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221—for requesting voluntary publication or republication of an application.

§ 1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.

§ 1.497(d)—for filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage.

§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

■ 3. Section 1.52 is amended by revising paragraph (e)(5) to read as follows:

**§ 1.52 Language, paper, writing, margins, compact disc specifications.**

(e) \* \* \*

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

■ 4. Section 1.71 is amended by revising paragraph (g) to read as follows:

**§ 1.71 Detailed description and specification of the invention.**

(g)(1) The specification may disclose or be amended to disclose the names of the parties to a joint research agreement (35 U.S.C. 103(c)(2)(C)).

(2) An amendment under paragraph (g)(1) of this section must be accompanied by the processing fee set forth in § 1.17(i) if not filed within one of the following time periods:

(i) Within three months of the filing date of a national application;

(ii) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(iii) Before the mailing of a first Office action on the merits; or

(iv) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

(3) If an amendment under paragraph (g)(1) of this section is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. If the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction

under 35 U.S.C. 255 and § 1.323 for the amendment to be effective.

■ 5. Section 1.76 is amended by revising paragraph (b)(5) to read as follows:

**§ 1.76 Application data sheet.**

(b) \* \* \*

(5) *Domestic priority information.*

This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(5), and need not otherwise be made part of the specification.

■ 6. Section 1.96 is amended by revising the introductory text of paragraph (c) to read as follows:

**§ 1.96 Submission of computer program listings.**

(c) *As an appendix which will not be printed:* Any computer program listing may, and any computer program listing having over 300 lines (up to 72 characters per line) must, be submitted on a compact disc in compliance with § 1.52(e). A compact disc containing such a computer program listing is to be referred to as a "computer program listing appendix." The "computer program listing appendix" will not be part of the printed patent. The specification must include a reference to the "computer program listing appendix" at the location indicated in § 1.77(b)(5).

■ 7. Section 1.104 is amended by revising paragraph (c)(4) to read as follows:

**§ 1.104 Nature of examination.**

(c) \* \* \*

(4) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or subject to an obligation of assignment to the same person at the time the claimed invention was made.

(i) Subject matter developed by another person and a claimed invention shall be deemed to have been commonly

owned by the same person, or subject to an obligation of assignment to the same person in any application and in any patent granted on or after December 10, 2004, if:

(A) The claimed invention and the subject matter was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) The claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(ii) For purposes of paragraph (c)(4)(i) of this section, the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

(iii) To overcome a rejection under 35 U.S.C. 103(a) based upon subject matter which qualifies as prior art under only one or more of 35 U.S.C. 102(a), (f) or (g) via 35 U.S.C. 103(c)(2), the applicant must provide a statement to the effect that the prior art and the claimed invention were made by or on the behalf of parties to a joint research agreement, within the meaning of 35 U.S.C. 103(c)(3) and paragraph (c)(4)(ii) of this section, that was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

**§ 1.109 [Removed and reserved]**

■ 8. Section 1.109 is removed and reserved.

■ 9. Section 1.321 is amended by revising paragraphs (c) and (d) to read as follows:

**§ 1.321 Statutory disclaimers, including terminal disclaimers.**

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

(d) A terminal disclaimer, when filed in a patent application or in a reexamination proceeding to obviate double patenting based upon a patent or application that is not commonly owned but was disqualified under 35 U.S.C. 103(c) as resulting from activities undertaken within the scope of a joint research agreement, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or be signed in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision waiving the right to separately enforce any patent granted on that application or any patent subject to the reexamination proceeding and the patent or any patent granted on the application which formed the basis for the double patenting, and that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent and the patent, or any patent granted on the application, which formed the basis for the double patenting are not separately enforced.

### PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

■ 10. The authority citation for 37 CFR part 3 continues to read as follows:

**Authority:** 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

■ 11. Section 3.11 is amended by revising paragraph (c) to read as follows:

#### § 3.11 Documents which will be recorded.

\* \* \* \* \*

(c) A joint research agreement or an excerpt of a joint research agreement will also be recorded as provided in this part.

Dated: September 7, 2005.

Jon W. Dudas,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. 05-18217 Filed 9-13-05; 8:45 am]

BILLING CODE 3510-16-P

## ENVIRONMENTAL PROTECTION AGENCY

### 40 CFR Part 52

[R08-OAR-2005-UT-0003; FRL-7961-7]

### Approval and Promulgation of Air Quality Implementation Plans; State of Utah; Ogden City Revised Carbon Monoxide Maintenance Plan and Approval of Related Revisions

**AGENCY:** Environmental Protection Agency (EPA).

**ACTION:** Direct final rule.

**SUMMARY:** EPA is taking direct final action approving State Implementation Plan (SIP) revisions submitted by the State of Utah. On November 29, 2004, the Governor of Utah submitted revisions to Utah's Rule R307-110-12, "Section IX, Control Measures for Area and Point Sources, Part C, Carbon Monoxide," which incorporates a revised maintenance plan for the Ogden carbon monoxide (CO) maintenance area for the CO National Ambient Air Quality Standard (NAAQS). The revised maintenance plan contains revised transportation conformity budgets for the years 2005 and 2021. In addition, the Governor submitted revisions to Utah's Rule R307-110-35, "Section X, Vehicle Inspection and Maintenance Program, Part E, Weber County," which incorporates a revised vehicle inspection and maintenance program for Weber County. In this action, EPA is approving the Ogden City CO revised maintenance plan, the revised transportation conformity budgets, the revised vehicle inspection and maintenance program for Weber County, and the revisions to rules R307-110-12 and R307-110-35. This action is being taken under section 110 of the Clean Air Act.

**DATES:** This rule is effective on November 14, 2005 without further notice, unless EPA receives adverse comment by October 14, 2005. If adverse comment is received, EPA will publish a timely withdrawal of the direct final rule in the *Federal Register* informing the public that the rule will not take effect.

**ADDRESSES:** Submit your comments, identified by RME Docket Number R08-OAR-2005-UT-0003, by one of the following methods:

- Federal eRulemaking Portal: <http://www.regulations.gov>. Follow the on-line instructions for submitting comments.
- Agency Web site: <http://docket.epa.gov/rmepub/index.jsp>. Regional Materials in EDOCKET (RME), EPA's electronic public docket and

comment system for regional actions, is EPA's preferred method for receiving comments. Follow the on-line instructions for submitting comments.

- E-mail: [long.richard@epa.gov](mailto:long.richard@epa.gov), [russ.tim@epa.gov](mailto:russ.tim@epa.gov), and [mastrangelo.domenico@epa.gov](mailto:mastrangelo.domenico@epa.gov).

- Fax: (303) 312-6064 (please alert the individual listed in the FOR FURTHER INFORMATION CONTACT if you are faxing comments).

- Mail: Richard R. Long, Director, Air and Radiation Program, Environmental Protection Agency (EPA), Region 8, Mailcode 8P-AR, 999 18th Street, Suite 300, Denver, Colorado 80202-2466.

- Hand Delivery: Richard R. Long, Director, Air and Radiation Program, Environmental Protection Agency (EPA), Region 8, Mailcode 8P-AR, 999 18th Street, Suite 300, Denver, Colorado 80202-2466. Such deliveries are only accepted Monday through Friday, 8 a.m. to 4:55 p.m., excluding federal holidays. Special arrangements should be made for deliveries of boxed information.

**Instructions:** Direct your comments to RME Docket Number R08-OAR-2005-UT-0003. EPA's policy is that all comments received will be included in the public docket without change and may be made available at <http://docket.epa.gov/rmepub/index.jsp>, including any personal information provided, unless the comment includes information claimed to be Confidential Business Information (CBI) or other information whose disclosure is restricted by statute. Do not submit information that you consider to be CBI or otherwise protected through EDOCKET, [regulations.gov](http://regulations.gov), or e-mail. EPA's Regional Materials in EDOCKET and federal [regulations.gov](http://regulations.gov) website are "anonymous access" systems, which means EPA will not know your identity or contact information unless you provide it in the body of your comment. If you send an e-mail comment directly to EPA, without going through EDOCKET or [regulations.gov](http://regulations.gov), your e-mail address will be automatically captured and included as part of the comment that is placed in the public docket and made available on the Internet. If you submit an electronic comment, EPA recommends that you include your name and other contact information in the body of your comment and with any disk or CD-ROM you submit. If EPA cannot read your comment due to technical difficulties and cannot contact you for clarification, EPA may not be able to consider your comment. Electronic files should avoid the use of special characters, any form of encryption, and be free of any defects or viruses. For additional information about EPA's public docket visit